

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*HSA*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/554,969 05/23/00 FRANKENBACH

G 7258X

EXAMINER

IM52/0622

ROBERT B AYLOR  
THE PROCTER & GAMBLE COMPANY  
11520 REED HARTMAN HIGHWAY  
SHARON WOODS TECHNICAL CENTER  
CINCINNATI OH 45241-2422

HARDEE, J

ART UNIT

PAPER NUMBER

1751

DATE MAILED:

06/22/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/554,969

Applicant(s)  
Frankenbach et al.

Examiner  
John R. Hardee

Art Unit  
1751



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 12-39 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 12-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 20) ☐ Other:

Art Unit: 1751

## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant has stated on the record that it is known in the art that all of the recited stabilizers will act in the same way in the context of the claimed invention. As this amounts to an admission that the use any of these stabilizers is obvious over the disclosure of another, this portion of the restriction requirement is withdrawn. In addition, applicant has stated that the phase stabilizers are in all cases optional.

With regard to the fabric softener portion of the restriction requirement, Markush practice does not apply because the independent claim does not recite fabric softeners in Markush form.

2. Applicant's election with traverse of Group VII in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the claims avoid the prior art. This is not found persuasive because of the prior art rejections made below.

The requirement is still deemed proper and is therefore made FINAL. The claims have only been searched to the extent that they read on combinations of the recited fabric softeners.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1751

4. Claims 1, 12-28 and 35-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Among the phase stabilizers recited in claims 1 and 26 are "amine-oxide fatty alcohol" compounds which have been ethoxylated. The examiner, not knowing what an amine-oxide fatty alcohol is, believes that a comma should be placed between amine oxide and fatty alcohol, otherwise claim 39 would not further modify claim 1. The claims have been examined on this basis. If this is correct, a comma should be inserted in the appropriate places in the claims and in the specification.

In claim 16, parts 4 and 6, and claim 17, parts 6 and 8, no definition of "substantially" is provided. Applicant is cautioned to refrain from adding new matter when addressing this. These are exemplary. Applicant should carefully proofread the claims for other language of this sort.

Applicant has claimed an "effective amount" of a solvent. Effective to do what? Liquefy the compositions? Make the compositions transparent?

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1751

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 12-15 and 17-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/03169. The reference discloses concentrated fabric softening compositions made using a principal solvent with a ClogP of about 0.15 to about 0.64 in combination with ester quats (abstract). Suitable ester quats are depicted in Fig. 1 on p. 18 and Fig. 2. on p. 23. Compositions may further comprise solvents such as ethanol and isopropyl alcohol, which have much lower Clog P values (see examples). Compositions may further comprise electrolytes, such as calcium and magnesium salts, especially the chlorides, to improve the clarity of the solutions (claim 51).

Art Unit: 1751

Examiner takes the position that "about 0.15 to about 0.64" reads on ClogP values outside that range. Solvents outside this range may be added (claim 53). Combinations of these two types of ester quats are not explicitly taught, but the examiner takes the position that it is prima facie obvious to combine two compositions, each taught for the same purpose, to yield a third composition for that very purpose. *In re Kerkhoven*, 205 USPQ 1069, *In re Pinten*, 173 USPQ 801, and *In re Susi* 169 USPQ 423. When ingredients are well known and combined for their known properties, the combination is obvious absent unexpected results. *In re Crocket*, 126 USPQ 186 and *In re Pinten*, 173 USPQ 801. The person of ordinary skill in the surfactant art would expect combinations of these materials to behave in the same fashion as the individual materials, absent unexpected results. The examiner takes the position that the ester quats exhibit the claimed phase transition temperatures, as they meet the claimed structural limitations. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a surfactant composition. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

Art Unit: 1751

In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed Cir. 1990).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (703) 305-5599. The examiner can normally be reached on Monday through Friday from 7:30 until 4:00. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (703) 308-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'J. Hardee', with a stylized, cursive script.

John R. Hardee  
Primary Examiner  
June 21, 2001